

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application : Panin G.

Serial No. : 10/579,814 Confirmation No. 5953

Art Unit : 1619

Filed : October 13, 2006

Examiner : Mattison, L. K

For : **COSMETIC AND/OR DERMATOLOGICAL
COMPOSITIONS CONTAINING POLYPHENOLS
STABILIZED BY PERFLUOROPOLYETHER
PHOSPHATES AND USE OF PERFLUOROPOLYETHER
PHOSPHATES AS STABILIZING AGENTS FOR
POLYPHENOLS**

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Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Pre-Appeal Brief

Sir:

Applicant submits this Pre-Appeal Brief, together with a Notice of Appeal and a petition for a two month extension of time in the above-identified application. Thus, this Pre-Appeal Brief is timely filed.

REMARKS

Claims 16-38 and 42 are the subject of Applicant's appeal. The presently claimed invention is directed to:

A cosmetic and/or dermatological composition for topical use, comprising:
polyphenols with a suitable carrier and
at least one perfluoropolyether phosphate for effectively stabilizing the polyphenols
against oxidative degradation.

(*e.g.*, page 4, lines 10-17).

The Examiner has rejected claims 16, 20-21, 23 and 38 under 35 U.S.C. § 103(a) for allegedly being obvious over the combination of EP 1,074,243 to Pantini (hereinafter "Pantini") in view of U.S. Patent No. 6,066,311 to Cheetam et al. (hereinafter "Cheetam"). The Examiner has also rejected the other claims over a combination of Pantini and Cheetam in further view of additional references. However, as claim 16 is the only independent claim and it has not been rejected over the additional combinations, Applicant addresses herein only the rejection over Pantini and Cheetam.

As submitted in the arguments presented in Applicant's responses of May 2, 2011 and August 14, 2009, Pantini only describes (per)fluoropolyethers as presently claimed, but with regard to emulsion stability only(*e.g.*, page 9, lines 14-19 of May 2, 2011 response and page 11, lines 3-11 and 19-20). Moreover Pantini discloses a composition with multiple purposes such as for skin protection against irritating agents, hair protection, hair treatment, skin protection against sun radiation, detergency, deodorants, after-shaves, disinfectants for external use, nail-varnish removal and make-up (*e.g.*, page 4 paragraph [0025]).

As also previously submitted, Cheetam does not provide for Applicant's invention nor makes up for Pantini's deficiencies. Specifically, Cheetam only discloses caffeic acid and derivatives in the context of sunscreen additives (*e.g.*, col. 1, lines 3-5).

Thus, for the following reasons it is respectfully submitted that the combination of Pantini with Cheetam would not have rendered obvious the claimed subject matter to one skilled in the art.

First, even where a general method that could have been applied to make the claimed product was known and within the level of skill of the ordinary artisan, the claim may nevertheless be nonobvious if the problem which had suggested use of the method had been previously unknown. *In re Omeprazole Patent Litigation*, 536 F.3d 1361 (Fed. Cir. 2008). Pantini and/or Cheetam do not recognize the problem of oxidative phenols' degradation. Accordingly, their combination cannot render obvious the claimed subject matter which is directed to a composition comprising polyphenols and at least one perfluoropolyether effective for stabilizing the phenols against oxidative degradation.

Second, Pantini discloses a number of possible uses for the composition described therein. Accordingly, a person skilled in the art would not know, nor would have any motivation to add the caffeic acid described by Cheetam to a specific use of the composition disclosed by Pantini.

Moreover, Applicant submits that the Examiner's reasoning in the Advisory Action issued on May 18, 2011 is circular. The Examiner has taken the position that because Pantini explicitly teaches using sun filters in sun protective gels, an artisan would be motivated to add the caffeic acid described by Cheetam to the composition described by Pantini. However, this reasoning is flawed and incorrect.

First, as submitted above, Pantini discloses many different applications for its composition, one of which is a sun cream gel which already comprises UV filters (*e.g.*, page 10). Thus, one skilled in the art would find no motivations for adding an additional UV filter to the composition disclosed by Pantini.

Second, exactly because Pantini already discloses a sun cream with UF filter, but it also discloses other applications for its composition, one skilled in the art would not know to what to add the caffeic acid and for which purpose. Thus, for this additional reason it is respectfully submitted that the combination of Pantini and Cheetam cannot render obvious the claimed subject matter.

Third, as submitted above, the combination of cited references does not recognize the problem of oxidative phenols degradation prevented by the presence of perfluoropolyether phosphates. The fact that Pantini include perfluoropolyether in its composition in addition to UV screening substances, render the allegedly combination with Cheetam improper because based on hindsight. Since the perfluoropolyether described by Pantini has the only purpose of improving the stability of the emulsion, a person skilled in the art would not even consider adding caffeic acid to the composition of Pantini which already comprises UV screening substances of chemical or physical types as butylmethoxybenzoylmethane, octylmethoxycinnamate or titanium dioxide.

Thus, for all of these reason, it is respectfully submitted that Pantini and Cheetam cannot be combined as proposed by the Examiner to render obvious the subject matter of claim 16, 20-21, 23 and 38.

As set forth above, if an independent claim is non-obvious under 35 U.S.C. § 103, then any claim depending therefrom is non-obvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). As claims 17-38 and 42 all depend, either directly or indirectly, from claim 16

which is not rendered obvious by the combination of Pantini and Cheetam in view of the additional references' combinations, it is respectfully submitted that claims 17-38 and 42 are also patentable over the additional references' combinations.

Accordingly, Applicant respectfully submits that the Examiner's rejection of claims 16-38 and 42 is untenable and should be overturned.

The Director is authorized to charge any deficiency, or credit any overpayment, to Deposit Account No. 02-2275.

Dated: June 21, 2011

Respectfully submitted,

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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) 405.1001									
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] on _____ Signature _____ Typed or printed name _____	Application Number 10/579,814		Filed 10/13/2006								
	First Named Inventor Giorgio Panin										
	Art Unit 1619		Examiner Mattison, Lori K.								
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <table style="width: 100%; border: none;"><tr><td style="width: 50%; vertical-align: top; padding: 5px;"><input type="checkbox"/> applicant/inventor.</td><td style="width: 50%; vertical-align: top; padding: 5px; text-align: right;">/Silvia Salvadori/ _____ Signature</td></tr><tr><td style="vertical-align: top; padding: 5px;"><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</td><td style="vertical-align: top; padding: 5px; text-align: right;">Silvia Salvadori _____ Typed or printed name</td></tr><tr><td style="vertical-align: top; padding: 5px;"><input checked="" type="checkbox"/> attorney or agent of record. Registration number 48,265</td><td style="vertical-align: top; padding: 5px; text-align: right;">646-783,6758 _____ Telephone number</td></tr><tr><td style="vertical-align: top; padding: 5px;"><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____</td><td style="vertical-align: top; padding: 5px; text-align: right;">June 21, 2011 _____ Date</td></tr></table> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.</p>				<input type="checkbox"/> applicant/inventor.	/Silvia Salvadori/ _____ Signature	<input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)	Silvia Salvadori _____ Typed or printed name	<input checked="" type="checkbox"/> attorney or agent of record. Registration number 48,265	646-783,6758 _____ Telephone number	<input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____	June 21, 2011 _____ Date
<input type="checkbox"/> applicant/inventor.	/Silvia Salvadori/ _____ Signature										
<input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)	Silvia Salvadori _____ Typed or printed name										
<input checked="" type="checkbox"/> attorney or agent of record. Registration number 48,265	646-783,6758 _____ Telephone number										
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